

REMARKS

Claims 1-16 have been rejected by the Examiner under 35 USC 112, first paragraph, based upon the claim language which includes the legs having a pair of spaced apart holes. Amendment to the claims has been made to properly define the holes disposed in the rail and spreader which are aligned with corresponding spreader slots.

Claims 3, 7 and 13 have been rejected by the Examiner under 35 USC 112, second paragraph, have been cancelled.

Traverse of the remaining rejections by the Examiner will be made on the basis of the amended claims.

In that regard, claim 1 has been rejected by the Examiner under 35 USC 103(a) as being unpatentable over U.S. 3,035,660 to Leon in view of U.S. Des. 315,025 to Hall. In this rejection, the Examiner states that Leon shows the claimed sawhorse with the exception of holes and therefore relies on Hall for showing a sawhorse having rails, spreader, and legs with spaced holes. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sawhorse of Leon to be constructed with the material with spaced holes as taught by Hall to enable a strong lightweight construction.

While Hall shows a collapsible sawhorse with a plurality of holes, such holes are only present for a decorative purpose. No function of the holes is described

or implied by Hall inasmuch as only the design is disclosed.

While Hall illustrates a plurality of holes, there is no teaching that such holes are alignable with one another when a rail spreader and legs are stacked. The Applicant accordingly submits that in view of this lack of teaching, there is no motivation for combining the references. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification, hence the claimed invention, obvious, unless the desirability is such that motivation is suggested by the prior art.

Clearly, there is no suggestion in the prior art to combine the Leon and Hall references in order to provide the rails, spreader, and legs with alignable holes. The claimed invention including alignable holes cannot be used as an instruction manual or "template" to piece together the teachings of the prior art so that claimed invention is rendered obvious. *In re Fritch*, 23 USPQ 2d 780 (CAFC 1992). Accordingly, the Examiner has not made a prima facie case of obviousness under 35 USC 103 for claims 1 and 3 on the basis of the Leon and the Hall references.

Claim 2 has been rejected by the Examiner under 35 USC 103(a) on the basis of the Leon and Hall references as applied to claim 1 and further in view of U.S. 4,923,051 to Newville. The features of claim 2 have been incorporated into claim 1. In this rejection, the Examiner states that Newville shows side rails and it would have been obvious to one of ordinary skill at the time the invention was made to

provide Leon with side rails as taught by Newville to form a platform. However, Newville is totally silent with regard to holes disposed in the side rails spaced apart for enabling alignment with holes in the rail and spreader as well as the spreader slot for enabling a cord to pass therethrough. Thus, all of the references cited by the Examiner and taken in combination do not teach or suggest this feature.

Claims 4, 10, 11, and 16 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Leon and Hall which applied to claim 1 and further in view of U.S. 4,943,035 to Thomson, et al. In this rejection, the Examiner states that Thomson shows a handle for passing through holes of a column and concludes it would have been obvious to one of ordinary skill in the art at the time the invention to provide Leon with a handle as taught by Thomson.

Clearly, Thomson, et al. does not teach a handle which extends through a column of holes, but rather teaches a disassembled spreader which is clamped between two leg assemblies and held in place by notches in the disassembled spreader.

The Examiner has relied on specific features found in each of the reference. However, it is not "features" but subject matter of the invention "as a whole" that must be considered under 35 USC 103. The fact that features, even distinguishing features, are "disclosed" in the prior art is not alone sufficient. The test is whether the claimed invention as a whole in the light of all teachings of

reference in their entireties would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears Roebuck and Company, 220 USPQ 193 (CAFC 1983) as well as Supreme Court in Graham, et al. v. John Deere Company, 148 USPQ 459 (1966).

On this basis, the Applicant submits that the Examiner has not made a *prima facie* case of obviousness.

Claims 5-6 and 12 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Leon, Hall, Thomson, and further in view of Newville. The Applicant respectfully resubmits the arguments hereinabove presented in traverse of this rejection.

Claims 8, 9, 14, and 15 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Leon, Hall, Newville, and further in view of U.S. 3,315,574 to Field, et al. In this rejection, the Examiner states that Field shows a handle 14 with dowed 26 stops and concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Leon with a handle as taught by Fields which is capable of being used as a handle for the sawhorse.

Again, the Applicant submits that determination of obviousness under 35 USC 103 requires analysis of the claimed invention as a whole and focusing on obviousness of substitutions and differences instead of the invention as a whole is an improper way to simplify the obviousness determination.

The Applicant submits that the Examiner has assembled this collection of prior art only on the basis of the teachings of the present application.

In determining patentability of claims, the Examiner must do so from a vantage point of one having ordinary skill in this specific art and then determining whether the claimed invention would have been obvious to such a person at the time the invention was made. This requires the Examiner to view the art without reading into that art the teachings of the Applicant's invention. *In re Spork*, 133 USPQ 360 (CCPA 1962).

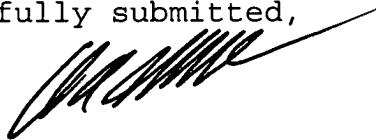
That is, while it might be possible to select statements from references and mechanically combine them with other references to arrive at the Examiner's claimed combination, there is no basis for making such a combination. Only the Applicant's specification suggests any reason for combining the teachings of the prior art but the use of such suggestion is improper under 35 USC 103. *In re Pye and Peterson*, 148 USPQ 426 (CCPA 1966).

Only with the present application at hand would one find four references, namely Leon, Hall, and Newville and Fields in order to so assemble the present invention and the Applicant submits that such action does not provide a basis for finding a *prima facie* case of obviousness.

In view of the arguments hereinabove set forth and amendment to the claims, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious

to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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